

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

K6510.0064/P064

Application Number

10/721,150-Conf.
#5542

Filed

November 26, 2003

First Named Inventor

Yoshifumi Ishihata et al.

Art Unit

3714

Examiner

D. J. Pierce

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant /inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 41,198

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.

Signature

Gianni Minutoli

Typed or printed name

(202) 420-2232

Telephone number

May 23, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of 1 forms are submitted.



Docket No.: K6510.0064/P064
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yoshifumi Ishihata et al.

Application No.: 10/721,150

Confirmation No.: 5542

Filed: November 26, 2003

Art Unit: 3714

For: CONTROL PROGRAM FOR ACTION GAME

Examiner: D. J. Pierce

ARGUMENTS TO ACCOMPANY THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby submit the following Arguments, in five (5) or fewer total pages, as attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

ARGUMENTS

Applicants' arguments in the Amendment After Final Action Under 37 C.F.R. 1.116 filed on March 24, 2008, in response to the final Office Action mailed January 23, 2008, were not properly considered or responded to by the Examiner in the Advisory Action mailed April 18, 2008. The Examiner's response was legally and factually deficient because Sanbongi fails to teach each and every element of independent claims 21, 22, 31, and 34. In fact, Sanbongi fails to teach multiple elements in each of the claims.

The Examiner has rejected claims 21-34 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,217,446 to Sanbongi *et al.* (hereinafter "Sanbongi"). However, it should be noted that the absence of any claimed element from the Sanbongi negates anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

The Examiner relies upon Sanbongi's Figure 7 and RAM 103 (Figure 1), described in Col. 6, lines 3-7 of Sanbongi, to allegedly teach that a control program, when executed by a computer, causes a

computer to *memorize respective distances of said plurality of characters from said predetermined base point before a predetermined time from present time in said memory*, as set forth in independent claim 21. For example, the Examiner contends that RAM 103 continuously stores distances of enemy characters E1, E2, etc. relative to the game character. Final Office Action, p. 3; Advisory Action, p. 2. However, upon inspection, nothing in the cited material or any other portion of Sanbongi teaches that the distances of the enemy characters are memorized *before a predetermined time from present time in said memory*, as suggested by the Examiner. In fact, the Examiner states that the distances are *continuously* stored in the RAM 103, which supports Applicants' position that the alleged predetermined time is not even contemplated by Sanbongi.

On page 2 of the Advisory Action, the Examiner points to Col. 3, lines 24-28 of Sanbongi to suggest that Sanbongi teaches memorizing a distance of an enemy character before a predetermined time from present time. However, the cited material merely explains that the gaze point can be placed at the target position of the character's movement in a certain amount of time that is predetermined, which is not the same as memorizing a distance of an enemy character before a predetermined time from present time, as suggested by the Examiner. For at least these reason, Sanbongi fails to teach the above-recited feature of claim 21.

The Examiner relies upon Sanbongi's ROMs 102, 109, and 111 (Figure 1), described in Col. 6, lines 20-30 of Sanbongi, to allegedly teach that a control program, when executed by a computer, causes a computer to *judge each of said plurality of characters as to whether or not it is a selectable candidate object based upon a content of said memory and whether its distance before said predetermined time is below said first distance and additionally its distance at said present time is below said second distance, or whether its distance at said present time is below said first distance*, as set forth in independent claim 21. For example, the Examiner contends that ROM 111 determines which characters are "enemies," subject to being attacked by the player. Final Office Action, p. 3; Advisory Action, p. 2. The Examiner further contends that landscape data from ROM 109 determines the placement of enemy characters and, based on their locations, determines whether they are subject to be attacked by the player. Final Office Action, p. 4. However, the Examiner's contentions are not supported by the disclosure in Sanbongi for at least the reasons set forth on pp. 12-13 of the Amendment After Final Action Under 37 C.F.R. 1.116.

Furthermore, the Examiner relies upon Col. 9, lines 47-51 and Col. 9, line 56 – Col. 10, line 3 of Sanbongi to contend that the enemy characters must be beyond the "attacking zone" in order to attack the player, arguing that the "attacking zone" is at a predetermined distance and angle. Advisory Action, p. 2. However, the Examiner's logic seems somewhat confused. For example, an enemy in the attacking zone is allowed to attack the player; whereas, an enemy that is not in the attacking zone is not allowed to attack the

player. Sanbongi, Col. 9, lines 44-55. This has nothing to do with judging the enemy players as to whether they are selectable candidate objects, as suggested by the Examiner. More specifically, nothing in the cited material or any other portion of Sanbongi teaches that each of the enemy characters is judged as to whether or not it is a selectable candidate object based upon its distance. To the contrary, although the number of enemy characters allowed to attack the player may be limited in accordance with the difficulty grade of the game scene, it appears that each of the enemy characters is selectable by the player, regardless of its distance from the player. Thus, it does not appear that the enemy characters are judged as to whether they are selectable candidate objects at all.

Moreover, the judging step of independent claim 21 is *based upon a content of said memory and whether its distance before said predetermined time is below said first distance and additionally its distance at said present time is below said second distance, or whether its distance at said present time is below said first distance*, which Sanbongi fails to teach, as explained in greater detail on pages 13-14 of the Amendment After Final Action Under 37 C.F.R. 1.116. Thus, Applicants assert that Sanbongi fails to teach the above-recited feature of claim 21.

The Examiner relies upon Figure 7 of Sanbongi to allegedly teach that a control program, when executed by a computer, causes a computer to *decide an order of selecting those of said judged plurality of selectable candidate objects based upon those distances at said present time of said plurality of selectable candidate objects*, as set forth in independent claim 21. For example, the Examiner contends that when enemy characters are within an angle of 180 degrees of the player and in the attacking zone, they are subject to attack the player. Advisory Action, p. 2. Relying upon Col. 9, lines 36-38 and Col. 10, lines 5-8 of Sanbongi, the Examiner further contends that the “‘ROM’ game program” decides the order of enemy characters, and the order is based upon the zone in which the enemy character is located at the present time. *Id.* However, the Examiner’s logic again seems somewhat confused. First, the “‘ROM’ game program” does not decide an order of selecting enemy characters based upon distances at the present time, as suggested by the Examiner. To the contrary, enemy characters in the attacking zone are merely allowed to attack the player; whereas, enemy characters that are not in the attacking zone are not allowed to attack the player. Sanbongi, Col. 9, lines 44-55. Second, whether the enemy characters are allowed to attack the player has nothing to do with deciding an order of selecting judged enemy characters. Thus, Applicants assert that Sanbongi fails to teach the above-recited feature of claim 21.

Applicants therefore assert that independent claim 21 is distinguishable over Sanbongi. Furthermore, claims 23, 25, 27, 29, and 30, all of which depend from independent claim 21, are also

distinguishable over Sanbongi for at least the same reasons as those set forth above with respect to independent claim 21, and further in view of their own respective features.

The Examiner relies upon Col. 3, lines 24-28, Figure 7, and RAM 103 of Figure 1 as described in Col. 6, lines 3-7 of Sanbongi to allegedly teach that a control program, when executed by a computer, causes a computer to *memorize respective angles of said plurality of characters from said predetermined base line before a predetermined time from present time in said memory*, as set forth in independent claim 22. For example, the Examiner contends that RAM 103 continuously stores data relative to the “gaze point”, such as angles of enemy characters E1, E2, etc. relative to the game character. Final Office Action, p. 3; Advisory Action, p. 2. However, Sanbongi fails to teach the above-recited feature of claim 22 for at least reasons similar to those set forth above with respect to claim 21.

The Examiner relies upon ROMs 102, 109, and 111 of Figure 1 as described in Col. 6, lines 20-30 of Sanbongi to allegedly teach that a control program, when executed by a computer, causes a computer to *judge each of said plurality of characters as to whether or not it is a selectable candidate object based upon a content of said memory and whether its angle before said predetermined time is below said first angle and additionally its angle at said present time is below said second angle, or whether its angle at said present time is below said first angle*, as set forth in independent claim 22. However, Sanbongi fails to teach this feature for at least reasons similar to those set forth above with respect to claim 21.

Furthermore, while the picture processing device of Sanbongi controls the gaze point movement of the virtual camera in corresponding with the angle of deviation between the current position of the character arranged inside the three-dimensional virtual space and the target position to which the character is to move [Sanbongi, Col. 3, lines 3-9], this angle of deviation has nothing to do with *judging each of the enemy characters as to whether or not it is a selectable candidate object*. Nothing in the cited material or any other portion of Sanbongi teaches that each of the enemy characters is judged as to whether or not it is a selectable candidate object based upon its angle, as suggested by the Examiner. To the contrary, although the number of enemy characters allowed to attack the player may be limited in accordance with the difficulty grade of the game scene, it appears that each of the enemy characters is selectable by the player, regardless of its angle from the player. Thus, it does not appear that the enemy characters are judged as to whether they are selectable candidate objects at all.

Moreover, the judging step of independent claim 22 is *based upon a content of said memory and whether its angle before said predetermined time is below said first angle and additionally its angle at said present time is below said second angle, or whether its angle at said present time is below said first angle*, which Sanbongi fails to teach, as explained in greater detail on pages 18-19 of the Amendment After Final

Action Under 37 C.F.R. 1.116. Thus, Applicants assert that Sanbongi fails to teach the above-recited feature of claim 22.

The Examiner relies upon Figure 7 of Sanbongi to allegedly teach that a control program, when executed by a computer, causes a computer to *decide an order of selecting those of said judged plurality of selectable candidate objects based upon those angles at said present time of said plurality of selectable candidate objects*, as set forth in independent claim 22. However, Sanbongi fails to teach this feature for at least reasons similar to those set forth above with respect to claim 21.

Applicants therefore assert that independent claim 22 is distinguishable over Sanbongi. Furthermore, claims 24, 26, and 28, all of which depend from independent claim 22, are also distinguishable over Sanbongi for at least the same reasons as those set forth above with respect to independent claim 22, and further in view of their own respective features.

Applicants assert that independent claim 31 and claims 32 and 33, which depend from independent claim 31, are also distinguishable over Sanbongi for at least reasons similar to those set forth above with respect to independent claim 21, and further in view of their own respective features. Moreover, independent claim 34 is also distinguishable over Sanbongi for at least reasons similar to those set forth above with respect to independent claim 22, and further in view of its own features.

Thus, Applicants assert that the Examiner's reliance upon Sanbongi in supporting the rejections under 35 U.S.C. § 102 is factually and legally unfounded. Applicants therefore respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 and that all pending claims be passed to allowance.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 04-1073, under Order No. K6510.0064/P064.

Dated: May 23, 2008

Respectfully submitted,

By  #41,198
Thomas J. D'Amico

Registration No.: 28,371

Bryan S. Wade

Registration No.: 58,228

DICKSTEIN SHAPIRO LLP

1825 Eye Street, NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicants